

Appl. No. 10/065,144
Amdt. Dated Nov. 30, 2005
Response to Office Action Dated Sept. 21, 2005

Remarks/Arguments:

Claims 1-4 and 8-17 were pending.

Claims 1-3 and 16 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement, because "greater than about 12%" would be inclusive of concentrations of up to 100% and "applicants' specification only provides support for a maximum of 28%" and "there is no support for the specific data point of 12%". Regarding an upper limit, paragraph [0012] and claims 1 and 3 as filed show that applicants imposed no upper limit on the acid concentration. In paragraph [0015] it states that "According to a preferred embodiment of the invention, the acid is hydrochloric acid and is added at a concentration of between about 3% and about 28% by weight..." That "between about 3% and about 28%" is preferred shows that other concentrations are envisioned. The Examiner further states that "there is no support for the specific data point of 12%". Applicants point out that with respect to changing numerical ranges, the decision of in re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) supports the position that an originally disclosed numerical range provides written description requirement support for amended claims with narrower ranges. One skilled in the art would recognize that the subject matter of claim 1 is described in the specification including the claims as filed so as to reasonably convey that the inventors had possession of the claim invention.

Claims 1-3 were rejected under 35 USC 103(a) as being unpatentable over Dahayanake (6,258,859). Claim 1 has been amended to claim greater than 12% organic acid instead of greater than "about 12%". In re DeVaney concludes that "about 7" does not mean "precisely 7" and that "between 7 and 8" would be covered by "about 8 to about 10". In re Ayers concludes that "at least about 8%" is anticipated by "at least about 10%". However, for organic acids or their salts, Dahayanake in claim 15 as filed claimed from about 0.1 to about 10% and in claim 11 as filed claimed from about 0.1 to about 8%; the present application in original claims 7 and 8 claimed "between 0.1 and

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10%" and "between 0.1 and 8%" respectively. Dahayanake considered "about 8" to be different from "about 10"; applicants clearly consider 8 to be different from 10. Consequently, applicants assert that in this instance, in context, "12%" organic acid in claim 1 is not suggested by the "at least about 10%" of Dahayanake; furthermore Dahayanake does not give any motivation to add more acid to their composition (and in fact gives a preferred range that does not include the upper limit).

Claims 1-3 were rejected under 35 USC 103(a) as being obvious over Lungwitz (2002/0033260). The undersigned asserts that the cited reference and the currently claimed invention were, at the time the claimed invention was made, both subject to an obligation of assignment to Schlumberger Technology Corporation. The reference is therefore disqualified as prior art.

Claims 1-3 were rejected under 35 USC 103(a) as being obvious over Brady (6,569,814). The undersigned asserts that the cited reference and the currently claimed invention were, at the time the claimed invention was made, both subject to an obligation of assignment to Schlumberger Technology Corporation. The reference is therefore disqualified as prior art.

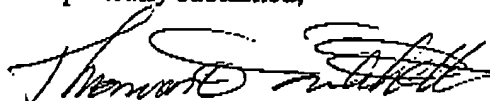
Claims 4, 8-15 and 17 were found allowable.

In light of the above amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

The Commissioner is authorized to charge any additional required fee, or credit any excess fee paid, to Deposit Account 04-1579 (56.0630).

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